



App. No. 09/652,279

Art. Unit 2632

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provisional application, 60/291,259. No new matter has been added by these amendments. It is Applicant's position that the amendments made herein are broader than actually required by the prior art and should not be construed as limiting any future doctrine of equivalents to matter that was not anticipated. However, to advance prosecution, and also to ease claim drafting, Applicant's contend that these amendments place the application in a condition for allowance.

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35 U.S.C. § 103

Examiner contends that it would have been obvious to one of ordinary skill in the art to modify the teachings of Tseng (U.S. Pat. No. 5,615,945) with the teachings of Kim (U.S. Pat. No. 6,147,682). Applicant respectfully disagrees.

I. Obviousness

In order for Examiner to provide a *prima facie* case of obviousness under 35 U.S.C. § 103(a), Examiner must disclose some suggestion or motivation, either commonly known or explicit in the references, to combine the two references; a reasonable expectation of success resulting from the combination; and the combined reference must teach all of the claim limitations. MPEP 2142. All of these requirements must be made at the time the invention was made, not at the present time. MPEP

2143.02.

A. The Examiner Has Not Provided a *Prima Facie* Case of Obviousness Because Proper Motivation to Combine the References Has Not Been Provided

The Examiner states that Tseng teaches a means for connecting a light source to the electric socket of a computer. Applicant claims connecting a light source to a variety of products via a USB standardized port. The Examiner suggests that, as Kim discloses other peripheral devices attached to a computer via USB ports, that it would have been obvious to connect the light of Tseng to a computer via a USB port. However, the USB taught by Kim transfers both data signal and power (see col. 6, lines 50-51). None of the peripheral devices taught by Kim transfer solely power. Therefore, one of ordinary skill in the art would have no motivation to utilize the peripheral device of Kim solely to transfer power.

In addition, Kim addresses the problem of the difficulty resulting from the multitude of cables required to connect peripheral devices to a computer (see col. 1, lines 38-43). Because the device in Tseng only has one cable and therefore does not contribute to the problem that Kim addresses, it would not have been obvious to one of ordinary skill in the art to utilize the USB of Kim in the teachings of Tseng.

Finally, Examiner argues that it would have been obvious to substitute the USB ports/connectors of Kim for the plug and socket of Tseng since it is difficult to connect peripheral devices to a computer. However, Tseng already teaches a plug and play

function. Therefore, there is no need to replace the plug and socket of Tseng because it is already an easy and well-understood connection system familiar to most people throughout the world.

As there is no motivation to combine Tseng and Kim, Examiner has failed to make a *prima facie* case of obviousness and this rejection should be withdrawn.

B. Fact that References Can Be Combined or Modified Is Not Sufficient to Establish *Prima Facie* Case of Obviousness

The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01. As discussed above, Tseng teaches a plug that easily connects to a lap top computer. Tseng teaches a peripheral device having only one cable. Kim teaches a one-plug connection mechanism for peripheral devices having multiple cables. As the invention of Tseng does not include any of the deficiencies Kim seeks to remedy, there is no motivation to combine the two.

Furthermore, merely asserting that modification to the prior art to meet the claimed invention would have been well within the ordinary skill in the art at the time the claimed invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a

prima facie case of obviousness without some *objective* reason to combine the teachings of the references. MPEP 2143.01. The only objective evidence provided is that it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the USB ports/connectors of Kim for the plug and socket of Tseng for connecting the flexible light device to the personal computer, since the computer is not provided with a plug and a play function, it is difficult to connect the peripheral devices to the computer, because the peripheral devices such as the keyboard, monitor, light pen, mouse, plotter are complicated to connect the personal computer. As stated previously, the light of Tseng is not difficult to connect to the computer and does not present the problem that Kim addresses. Therefore, Examiner has not provided an objective reason to combine Tseng and Kim and this rejection should be withdrawn.

C. The Proposed Modification Cannot Change the Principle of Operation

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. MPEP 2143.01. Tseng teaches the connection of a lighting device, which only requires electricity to operate, to a computer. Kim teaches the connection of multi-cabled peripherals, which require both data signal and power, to a computer. Substituting the USB

ports/connectors of Kim for the plug and socket of Tseng, as the Examiner suggests, would change the operation principle of Tseng. Therefore, this rejection fails under 35 U.S.C. 103 and should be withdrawn.

D. The Examiner Has Not Provided a *Prima Facie* Case of Obviousness Because No Expectation of Success Results from the Combination of the References

The Examiner states that Tseng teaches a means for connecting a light source to the electric socket of a computer. The Examiner suggests that, as it is difficult to connect the peripheral devices to the computer and Kim discloses a method to connect other peripheral devices to a computer via USB ports, that it would have been obvious to substitute the USB ports/connectors of Kim for the plug and socket of Tseng. As disclosed by Kim at col. 6, line 59, the power supplied over a USB is +5 volts. The lamp of the current invention utilizes 3.3 volts. One of ordinary skill in the art would have thought that the power supply of a USB port would provide too much power for such a small lamp. In particular, Kim, at col. 8, lines 52-55, does not list any peripheral components that operate on less than 5 volts as within the scope of his invention. Therefore, it is clear that Kim did not even consider a light source as a potential peripheral device because there would be no expectation of success using the USB without undue experimentation required to adjust the voltage to the needs of the light.

II. The References Cannot Be Combined Where Reference Teaches Away from Their Combination

A *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. MPEP 2144.05 III and 2145 X D 2. The Examiner states that Tseng teaches a means for connecting a light source to the electric socket of a computer. The Examiner suggests that, as Kim discloses other peripheral devices attached to a computer via USB ports, that it would have been obvious to connect the light of Tseng to a computer via a USB port. However, the USB taught by Kim transfers both data signal and power (see col. 6, lines 50-51). None of the peripheral devices taught by Kim transfer solely power. Therefore, by utilizing a USB port to transfer only power, the present invention actually teaches away from Kim.

Furthermore, Kim addresses the difficulty in connecting computer peripheral because of the number of cables. Tseng teaches a lighting device containing one cable. Kim addresses the difficulty in connecting peripherals that do not use a plug and play function. Tseng teaches a plug that can be connected to the electric power supply of the computer. The USB improvement of Kim teaches away from the teachings of Tseng because none of the problems Kim addresses are contained in Tseng.

CLEAN VERSION OF AMENDED CLAIMS

5. An illuminating device from the Universal Serial Bus (USB) comprising

a. an elongated, standard USB wire comprising:

i. a flexible, tubular stabilizing agent which is easily bendable, and

ii. having a first and a second end;

B. a USB connector electronically coupled to said first end of said elongated, standard USB wire;

41 C. an illuminating light(s) electronically coupled to said second end of said elongated, standard USB wire.

6. The illuminating device of claim 5 wherein said USB wire does not transfer data.

7. The illuminating device of claim 5 wherein said USB wire utilizes only positive and negative wires contained therein.

8. The illuminating device of claim 5 wherein said USB wire utilizes only the V_{Bus} wire and the GND wire.
